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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,462	02/13/2002	Stephen James	3610-20	3874

7590

07/29/2003

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EXAMINER

ROBERTSON, JEFFREY

ART UNIT

PAPER NUMBER

1712

DATE MAILED: 07/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

10/049,462

Applicant(s)

JAMES ET AL.

Examiner

Jeffrey B. Robertson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☒ Claim(s) 2-4,6 and 10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Priority***

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in the United Kingdom on 08/13/99. It is noted that no copy of the priority document is present in the application file. Although the examiner has requested a copy of the certified priority document from PCT, applicant is advised that the examiner will not be able to allow the case unless this document is present in the application file.

### ***Specification***

2. The disclosure is objected to because of the following informalities: On page 7, in paragraph [0013], R<sup>5</sup> is undefined.

Appropriate correction is required.

### ***Claim Objections***

3. Claims 2-4 and 6 are objected to because of the following informalities: For claim 2, in general structure (II), x is not italicized. However, x is italicized in line 7 of the claim. This should be changed so that the two agree. The same problem exists in

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claim 4 with respect to the x and z variables in general structure (III). For claim 6, the variables p and q are not underlined in the general formulas given, but they are underlined in claim 6. This should be changed so that the two agree. Appropriate correction is required.

4. Claims 2, 3, and 10 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. For claims 2, 3, and 10, for organopolysiloxane (b), general formula (II) in claim 2, the vinyl-terminated polydimethylsiloxanes of claim 3, and the recitation in claim 10 that organopolysiloxane (b) has only terminal silicon-bonded aliphatically unsaturated hydrocarbon groups fails to further limit claim 1. Claim 1 requires that organopolysiloxane (b) has only silicon-bonded aliphatically unsaturated hydrocarbon groups per molecule.

#### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to

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one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

For claim 1, in lines 4-5 of the claim, applicant defines component (b) as an organopolysiloxane material having only silicon-bonded aliphatically unsaturated hydrocarbon groups per molecule. This is new matter because the amendment is not supported by the specification, particularly on page 4, paragraph [0009], and the amendment is not referred to in the declaration. In the specification, the silicon-bonded aliphatically unsaturated hydrocarbon groups of organopolysiloxane (b) are limited to terminal groups, and not present throughout the polymer.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 4, 6, and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claim 4, applicant states that R and R' have the same meaning as given above. However, since claim 4 depends from claim 1 and claim 1 fails to disclose these variables, it is indefinite as to what R and R' mean in claim 4. For claim 10, applicant has referred to the catalyst and the filler as component (e). It is unclear if the hydrophobic filler set forth in claim 10 is the reinforcing filler (f) of claim 1. For claim 6, R<sup>5</sup> is undefined.

### ***Conclusion***

9. The examiner is not able to apply art on claim 1 as presently written with organopolysiloxane (b) having only unsaturated groups bound to silicon per molecule. None of the cited art below teaches or suggests such a polysiloxane. However, as set forth above, this constitutes new matter. If claim 1 included the word "terminal" after "only" in the definition of organopolysiloxane (b), the examiner would apply Nakano et al. (U.S. Patent No. 6,306,957). See column 8 line 64 through column 9, line 67 and column 4, lines 57-58. It is noted that this reference would only be applied because the priority document is missing in the application file. If the priority document were present in the application file, the examiner would not be able to apply this reference.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Baity et al. (U.S. Patent No. 5,908,878) teaches a combination of three different polysiloxanes containing unsaturated groups similar to applicant. However, Baity differs from the present claims in that Baity requires two polysiloxanes having both pendant and terminal unsaturated groups, where applicant allows only one polysiloxane with pendant unsaturated groups. In addition, Baity does not meet the viscosity requirements set forth by applicant.

Fujiki et al. (U.S. Patent No. 5,529,837) and Tsuji et al. (U.S. Patent No. 6,420,037) are cited for the general teaching of addition-curable silicone compositions used as coatings for airbags. Bracken et al. (U.S. Patent No. 5,539,020) is cited for

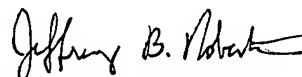
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general interest in teaching blends of high and low viscosity addition-curable polysiloxane compositions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey B. Robertson whose telephone number is (703) 306-5929. The examiner can normally be reached on Mon-Fri 7:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert A. Dawson can be reached on (703) 308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

  
Jeffrey B. Robertson  
Primary Examiner  
Art Unit 1712

JBR  
July 24, 2003